

PATENT
(Docket No. IN-5443)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Wolfgang DUSCHEK et al.

Serial No.: 09/743,049

Filed: January 17, 2001

For: Method for Determining Direction-
Dependent Properties of Enamels

Group Art Unit: 1762

Examiner: Bernard D. Pianalto

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1-14-2004

Date

Michael Morgan
Michael Morgan

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Commissioner for Patents

PO BOX 1450

Alexandria, VA 22313-1450

APPEAL BRIEF

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REAL PARTY IN INTEREST

The real party in interest in this appeal is BASF Coatings Aktiengesellschaft by virtue of an assignment, which was recorded at Reel/Frame: 011464/0531 on January 22, 2001.

RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences.

STATUS OF THE CLAIMS

Claims 1-14 are pending in this application, and all of these claims stand rejected. Claims 1-14 are appealed.

STATUS OF AMENDMENTS

No amendments to the claims have been filed after the mailing of the final rejection.

SUMMARY OF THE INVENTION

The present invention is directed to a method of determining direction-dependent properties of coatings comprising measuring at least one coating property along a test track on a sample coating using at least one measuring instrument to give at least one measurement, wherein a) at least one of the at least one measurement is recorded in relation to direction, b) the sample coating has at least one coat thickness that occurs at two points and at at least two different coat-thickness gradients along the test track, and c) the measuring is done at least at these two points.

ISSUES

Is the selection of the claimed test points for measuring the coating property disclosed or suggested by DE19611062 or United States Patent No. 5,500,274 to Francis et al.?

GROUPING OF THE CLAIMS

Claims 1-14 do stand or fall together.

ARGUMENT

Note, DE19611062 was filed in the United States via a PCT application, PCT/EP97/00555 on February 7, 1997. The PCT application published as WO97/30342 on August 21, 1997, and it was filed in the United States as Serial No. 08/860,384 on December 19, 1997, which issued as United States Patent No. 5,991,042 to Rupieper et al. on November 23, 1999.

The measuring of the coating properties in the claimed method is done at at least two points that have the same coating thickness but have different coat thickness gradients. To illustrate, one non-limiting example of this method can be seen in Figures 1 and 2. Measurements can be taken at points 5a and 5a'. Both of these points have the same coating thickness, but they have different coating thickness gradients (Figure 2).

There is no disclosure or suggestion in DE19611062 or Francis '274 that measurements are taken at least at these two points. In order to anticipate, when a reference discloses multiple variables and combinations, the reference must describe the combination with enough detail such that the combination is in the possession of the public. *In re Brown*, 329 F. 2d 1006, 1011, 141 U.S.P.Q. 245, 249 (C.C.P.A. 1964). Also, the reference must clearly and unequivocally disclose the combination or direct those skilled in the art to the combination without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the reference. *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). Additionally, under the obviousness standard, while it may be obvious to try to vary all parameters or try each of numerous possible choices, the reference must suggest the combination and selection of parameters. *In re O'Farrell*, 853 F.2d 894, 903, 7 U.S.P.Q.2d 1673, 1681 (Fed. Cir. 1988). While measurements can be taken at different points in DE19611062 or Francis '274, there is no disclosure or suggestion of selecting the claimed two points for measuring from all of the points on the coating.

Therefore, it is respectfully submitted that claims 1-7 are not anticipated by and claims 8-14 are patentable over either DE19611062 or United States Patent No. 5,500,274 to Francis et al.

FOR THESE REASONS, Applicants respectfully petition this Honorable Board to reverse the rejection set forth by the Examiner. Should the Board have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

Michael F. Morgan
Michael F. Morgan, Esq. (Reg. No. 42,906)
(248) 948-2355
BASF Corporation
26701 Telegraph Road
Southfield, MI 48034-2442

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